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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/416,252	10/12/1999	DAVID R. TUSHIE	457.003US3	5923

21186 7590 05/17/2005

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EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/416,252	Applicant(s) TUSHIE ET AL.	
	Examiner Mary Cheung	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-44 is/are pending in the application.
- 4a) Of the above claim(s) 35-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/12/99; 7/6/00; 2/14/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Status of the Claims

1. This action is in response to the restriction election filed on February 14, 2005.

Claims 25-44 are pending. Claims 25-34 are elected with traverse. Claims 25-34 are examined.

Response to Arguments

2. In response to the applicant's arguments regarding to restriction, examiner respectfully disagrees because different classification and subject matter searches are required for each restricted group. It would be a burden for the examiner to conduct thorough searches for all the claims, thus the restriction is proper.

3. Applicant's arguments with respect to claims 25-34 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 25-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Provost, U. S. Patent 6,335,799.

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As to claim 25, Provost teaches a method in personalization system of processing data for a portable programmed data carrier comprising (title and abstract):

(a) Acquiring personalization data for a cardholder (abstract and column 12 lines 15-20);

(b) Acquiring personalization equipment characteristics for particular personalization equipment (column 12 lines 20-26 and column 12 line 38 – column 13 line 47);

(c) Creating instruction for an internal script from the personalization data (column 12 line 54 – column 13 line 47);

(d) Translating the internal script into a data stream in accordance with the personalization equipment characteristics (column 12 line 38 – column 13 line 47; *specifically, this step corresponds to print the personal data (i.e. cardholder's name) on the card in Provost's teaching*).

As to claim 26, Provost teaches transferring the data stream to the particular personalization equipment to issue the data carrier (column 12 line 38 – column 13 line 47).

As to claim 27, Provost teaches creating the instructions comprises mapping the personalization data into a plurality of variables for the instruction (column 12 lines 30-38 and column 13 lines 40-53 and column 14 lines 30-61).

As to claims 28-29, Provost teaches translating the internal script into a data stream comprises translating instructions into personalization equipment program

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commands specified by the personalization equipment characteristics (column 12 line 38 – column 13 line 47 and Figs. 7A-7B).

As to claim 30, Provost teaches acquiring information for a card application, and wherein at least one of the plurality of variables holds data for the card application (column 14 lines 30-61).

As to claims 31-32, Provost teaches wherein the internal script includes instructions for a card operating system and further comprising: acquiring programming control commands for a card operating system; and translating the instructions for the card operating system into the programming control commands (column 12 line 38 – column 13 line 47).

As to claim 33, Provost teaches acquiring a security function; and adding the security function to the internal script (column 6 line 52 – column 7 line 22).

As to claim 34, Provost teaches the instructions for the internal script are specified in a set of database records (abstract and column 5 lines 12-21).

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 25-34 are rejected under the judicially created doctrine of double patenting over claims 1-26 of U. S. Patent No. 5,889,941 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: acquiring personalization equipment characteristics for particular personalization equipment and transferring the data stream to the particular personalization equipment to issue the data carrier.

8. Claims 25-34 are rejected under the judicially created doctrine of double patenting over claims 1-13 of U. S. Patent No. 6,014,748 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: acquiring personalization equipment characteristics for particular personalization equipment and transferring the data stream to the particular personalization equipment to issue the data carrier.

Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is 571-272-6705. The examiner can normally be reached on M-Th (10:00-7:30) Second Friday Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mary Cheung
Patent Examiner
Art Unit 3621
May 3, 2005

